

REMARKS

Claims 24-30 and 39-44 are in the application. Claims 1-23 and 31-38, standing withdrawn, have been cancelled, but this cancellation is not to be interpreted as abandonment of the invention of these claims or the abandonment of the pursuit of patent protection for these claims. Claim 24 has been amended to insert a maximum average fiber diameter of the fibers in the mat to be 20 microns, basis being found on page 8, lines 25-30 of the specification. Claim 25 has been amended to insert that the filler is inorganic, basis found in page 12, lines 29-37 of the specification.

Applicant believes the Examiner should enter this amendment because:

1. The amendments place the claims in better condition for allowance or for appeal to the Board of Appeals.
2. The Examiner's reasons for the rejection have changed since the first Office Action, i.e. that the claims are not commensurate in scope with a reasonable scope of the proofs in the specification and the allegation that Jaffee et al teaches using a similar high filler content in the coating.

The invention is a laminate containing a nonwoven fibrous mat containing a major portion of non-cellulosic fibers having an average fiber diameter of at least about 10 microns and up to 20 microns, the fibrous mat having a coating on a surface, the coating having an exposed surface having a surface smoothness Ra of no greater than about 15 microns, the coating comprising a filler. The novelty of the laminate of the invention lies in the type of mat and the degree of smoothness of the exposed surface of the fibrous mat. The claimed laminate provides a laminate made using something other than a cellulosic fiber mat, to avoid potential mold problems, and yet still

having a degree of smoothness needed in the industry for an exposed surface ready for painting, wallpapering, etc.

Claims 24-30, 39 and 40 stand rejected under 35 USC 103 as being unpatentable over Jaffee et al '187. The Examiner states that it is presumed that the mat or mats disclosed in this reference have the degree of surface smoothness of the claimed invention, but no proof is provided by the Examiner to support this presumption. This presumption is not correct as evidenced by the Examples, specifically Example 1 vs Example 2 and Example 7 vs Example 8, provided in the present application. Other examples show that different kinds of mats and different kinds of coatings, when made according to the present invention have the surface smoothness recited in the claims.

The coated mats taught by Jaffee et al are dried with the coating exposed to the air and hot gases in the oven, the manner of drying used in Examples 1 and 7, and show that drying in the conventional manner and the manner used by Jaffee et al produces a relatively smooth surface, but not nearly as smooth as possessed by the mats in the laminates of the claimed invention. There is no suggestion in Jaffee et al to at least partially drying the mat and/or the coating while it is in contact a smooth surface. This step in the manufacture of the coated mats is critical to the manufacture of the coated mat of claims of Groups I and II and to the method claims of Group III.

Examples 1 and 2 of the present specification show that when the same mat is coated with the same coating composition, Example 1, coated with essentially the same coating weight (19.9 gms/sq. ft. for Example 1 and 19.3 gms/sq. ft. for Example 2, and then dried in a conventional manner with the coated surface exposed to hot air and hot gases shows that the surface is not nearly so smooth as the surface of the mat made according to the invention, i.e. Example 2, Example 2 mat having the coating against a smooth surface during drying, had an Ra of 1.2 microns, substantially

smoother than the Ra of Example 1, 16 microns. This shows clearly that the Examiner's presumption of the surface smoothness of Jaffee et al is not right and is without support. Examples 5 and 6, compared with Example 1 also show this. Examples 7 (dried in a conventional manner of being exposed to the hot gases in the oven) and 8 (dried or partially dried in contact with a smooth surface) also prove the presumption wrong. The surface of the Example 8 mat made according to the invention had a surface smoothness Ra of 1.08 whereas the mat in Example 7, dried as taught by Jaffee et al, had a much less surface smoothness, an Ra of 18.2 microns. The examples in the specification are of sufficient diversity and scope, coupled with reasonable statements made by the applicant in the specification, as to provide reasonable basis for the scope of the claims.

It is well established that a rejection under 35 USC 102 or 35 USC 103 that is based on alleged inherent properties of a prior art product must be reasonable and have some basis in either the prior art reference or in the common knowledge of one skilled in the art. That is not present here because Jaffee et al did not teach or suggest that his mats had a surface smoothness within the range claimed in this application. Although the mats of Jaffee et al can be used as facers, Jaffee et al did not teach or suggest that the surface would be as smooth as kraft paper, see the present specification at page 3, lines 8-10. It is also well established that where the applicant has shown with evidence that the inherency urged by the Examiner is not correct, the inherency rejection is overcome.

The Examiner also urges that the higher percentage of filler used in the invention is obvious, in the sense of 35 USC 103, modification and provides no evidence of why one skilled in the art would believe that a higher filler content would better coat the fibers. The Examiner may be confusing the basis weight of the coating with the filler content of the coating. As shown by Examples 2, 3, 5 and 6, the higher the basis weight of the coating, when at least partially dried in contact with a smooth surface, does increase the

surface smoothness, but the Examiner has provided no evidence that it was known in the art that increasing the filler content in the coating produces a smoother surface or causes it to stick better to the fibers. Actually wet clay sticks better to the fibers than the wet filler. The Examiner seems to urge that Jaffee et al in col. 5, lines 10-17 teaches this, but in those lines Jaffee et al is talking about what can happen if the particles are of an organic thermoplastic or a flowable thermoset material, and not the how much filler is in the coating. Neither kaolin clay or limestone are organic thermoplastic or flowable thermoset materials.

For these reasons applicant believes that these claims are patentable and respectfully requests the Examiner to withdraw this rejection and to allow all of these claims. If the Examiner believes one or more issues still exist, to expedite a disposal of this application, the Examiner is invited to call applicants' attorney at the number below to discuss resolution.

Respectfully submitted,


Attorney for Applicant

Robert D. Touslee
Reg. No. 34,032
Tel. No. 303-978-3927
Fax No. 303-978-2323